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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/229,324 01/13/99 HIEI

Y 760-262P

EXAMINER

002292 HM12/0619
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PO BOX 747
FALLS CHURCH VA 22040-0747

ART UNIT	PAPER NUMBER
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1638

DATE MAILED:

06/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/229,324

Applicant(s)

HIEI ET AL.

Examiner

Gary Benzion

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/04/01.
- 2a) ☒ This action is **FINAL**.
- 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Status of the Application

Effective 24 January 2000, the Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1638.

Claims 1-61 are pending.

Detailed Action

Claims 1-16 remain provisionally rejected under copending claims 1-14 of application serial number 08/428,238 for the reasons of record as set forth in the previous Office action. Applicants argue that a period of one day is sufficient for dedifferentiation to occur. Applicants' arguments have been carefully considered and are not deemed persuasive.

Attention is directed to Hie et al. US Patent No: 5,591,616 which state:

The cultured tissue used in the method of the present invention is a cultured tissue **during the dedifferentiation process or a dedifferentiated cultured tissue**. The term "cultured tissue during the dedifferentiation process" herein means a tissue which is obtained by culturing an explant on a medium containing a plant growth regulator such as an auxin or a cytokinin, which tissue is before the stage that a callus or an adventitious embryo-like tissue is formed. The term **"dedifferentiated tissue"** herein means a callus or an adventitious embryo-like tissue obtained by culturing an explant in a medium containing a plant growth regulator such as an auxin or a cytokinin.

Thus according to this teaching a dedifferentiation process is measured by the formation of callus and it was well known in the art that callus formation is not measurable after one day. The rejection is maintained as the processes must inherently then be identical.

Claims 1-16 remain rejected under 35 U.S.C. § 112, first paragraph, for the reasons of record as set forth in the previous Office Action.

Applicants state that the examiner appears to misunderstand both the invention and the specification and point to numerous spots in the previous Office action to indicate his errors. Applicants' arguments have been carefully considered and are not deemed persuasive.

The citation of the paragraph at page 30 in the previous Office action was stated to be directed to comparative examples and not the instant invention. This statement is contrary to that stated at pages 27,

ultimate paragraph to pages 29. These are not comparative examples but experiments designed to elicit that dividing cells are required for transformation—a fact so widely known in the art prior to the instant invention it is unclear as to why this information was included in the specification. Dividing cells has everything to do with the ability to transform cells

With regard to the statement at page 44, lines 22-26, these are conclusionary statements and not statements of fact.

With regard to Southern data—as argued or presented in the declaration, that alone is not sufficient to demonstrate transformation especially in the absence of evidence of the DNA of interest in high weight molecular DNA.

With regards to arguments directed to the use of a superbinary vector as found in Schlappi et al. or Hiei et al., such arguments are not commensurate with the scope of the claimed invention.

Accordingly the rejection is maintained.

Summary

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Inquires

Any inquiry concerning this or earlier communication from the examiner should be directed to Gary Benzion, Ph.D. whose telephone number is (703) 308-1119. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. If attempts to reach the examiner by telephone are

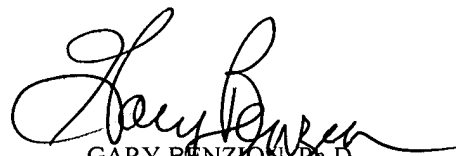
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unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703)-308-4310. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Benzion
06/15/01



GARY BENZION, Ph.D.
PRIMARY EXAMINER
GROUP ART UNIT 1638